

REMARKS

As a preliminary matter, Applicants appreciate the Examiner's indication that dependent Claims 8, 9, 12-15 and 29 contain allowable subject matter and would be allowed if amended to include the subject matter of the base claims and any intervening claims (and if amended to overcome the §112, second paragraph, rejection, with regard to Claims 12-15 only).

In response, Applicants have amended Claim 12 into independent form by including the subject matter of independent Claim 10 therein (which also overcomes the §112 rejection because Claim 12 now no longer refers to cancelled Claim 11). Accordingly, Applicants respectfully request an indication of the allowance of independent Claim 12 and associated dependent Claims 13-15. With regard to Claims 8 and 9, Applicants have opted not to amend these claims into independent form at this time. Finally, with regard to Claim 29, Applicants have cancelled this claim, without prejudice.

Claims 12-15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse this rejection.

As mentioned above, Applicants have amended Claim 12 into independent form by including the subject matter of independent Claim 10 therein. Thus, Claim 12 now no longer refers to cancelled Claim 11. Accordingly, Applicants respectfully request the withdrawal of this §112, second paragraph, rejection of Claim 12 and associated Claims 13-15.

Claims 19-26, 28, 30, 32 and 33 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by United States Patent No 5,486,178 to Hodge. (Although not listed in the first sentence of the rejection, Applicants believe that the Examiner intended to include Claim 29 in this rejection also.) Applicants have cancelled Claims 19-26, 28 and 29, without prejudice, thereby rendering this rejection moot with respect to these claims. However, with respect to Claims 30, 32 and 33, Applicants respectfully traverse this rejection.

Applicants respectfully submit that the Hodge reference fails to disclose all of the features of the present invention. More specifically, the Hodge reference fails to disclose the claimed system that includes, *inter alia*, a means for abutting that comprises a pivotable stop plate “with an abutment surface configured to abut a bone, wherein the abutment surface is located on both sides of the ruler in a plane that is generally transverse to the longitudinal direction of the ruler,” as defined in independent Claim 30.

One example of an embodiment of the present invention defined in Claim 30 that includes the claimed abutment surface is shown in Applicants’ Figure 3, which includes abutment surface 126 that is located on both sides of ruler 22 in a plane that is generally transverse to the longitudinal direction of the ruler, as represented by longitudinal axis 36.

In contrast, the device of Hodge lacks the claimed abutment surface. More specifically, when viewing Figures 1 and 3 of Hodge, the surface that most closely resembles that claimed abutment surface is the rear surface of guide block 40 (i.e., the surface facing the distal end of femur 10). However, this surface of guide block 40 is parallel to the longitudinal direction of ruler 100 (and not generally transverse to the longitudinal direction

of the ruler, as recited in Claim 30). Accordingly, as all of the features of Claim 30 are not disclosed in the Hodge reference, Applicants respectfully request the withdrawal of this §102(b) rejection of independent Claim 30 and associated dependent Claims 32 and 33.

Claims 1, 3-7, 10, 16-18, 30, and 32-38 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by United States Patent No 762,146 to Cosbie. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the Cosbie reference fails to disclose all of the features of the present invention. More specifically, the Cosbie reference fails to disclose, *inter alia*, the abutment surface of independent Claim 1 that is “configured to abut a bone, and . . . is positioned on both sides of the ruler.” Additionally, the Cosbie reference fails to disclose, *inter alia*, the abutment surface of independent Claim 10 that is “generally symmetric with respect to both sides of the longitudinal axis defined by the ruler.” Finally, the Cosbie reference fails to disclose, *inter alia*, the abutment surface of independent Claim 30 that is “located on both sides of the ruler in a plane that is generally transverse to the longitudinal direction of the ruler.”

One example of an embodiment of the present invention that includes the features of Claims 1, 10 and 30 is shown in Applicants’ Figures 1 and 3. The claimed abutment surface is designated as surface 126. Figures 1, 3 and 14 show how abutment surface 126 is configured to abut a bone, such as femur 152 of Figure 14, and is positioned on both sides of the ruler 22, as defined in independent Claim 1. Additionally, Figure 4 shows how abutment surface 126 is generally symmetric with respect to both sides of the

longitudinal axis 36 defined by the ruler 22, as defined in independent Claim 10. Finally, as mentioned above, abutment surface 126 is located on both sides of the ruler 22 in a plane that is generally transverse to the longitudinal direction 36 of the ruler, as defined in independent Claim 30.

In contrast, the device of Cosbie lacks the features described above. More specifically, the device of Cosbie lacks the claimed abutment surface defined in independent Claims 1, 10 and 30. Upon viewing Figure 1 of the Cosbie reference, it appears as though the surface of part 3 directed towards the top of the page is the feature that most closely resembles the abutment surface. However, this surface cannot be considered as the claimed abutment surface of Claim 1 because it not configured to abut a bone, nor is it positioned on both sides of the ruler designated as “A,” as defined in independent Claim 1. Further, the upward facing surface of part 3 of Figure 1 of Cosbie is not generally symmetric with respect to both sides of a longitudinal axis defined by the ruler “A,” as defined in independent Claim 10. Finally, the upward facing surface of part 3 of Cosbie is not located on both sides of the ruler “A” in a plane that is generally transverse to the longitudinal direction of the ruler “A”, as defined in independent Claim 30. Accordingly, as all of the features of independent Claims 1, 10 and 30 are not disclosed in the Cosbie reference, Applicants respectfully request the withdrawal of this §102(b) rejection of independent Claims 1, 10 and 30 and associated dependent Claims 3-7,16-18, and 32-38.

Claims 10, 16, 17, 30, 32 and 38 stand rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 4,718,850 to Knebelman. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the Knebelman reference fails to disclose all of the features of the present invention. More specifically, the Knebelman reference fails to disclose the measuring guide of independent Claim 10 that includes, *inter alia*, a stop plate that is “pivotal, with respect to a pivot point.” Further, the Knebelman reference fails to disclose the system of independent Claim 30 that includes, *inter alia*, the claimed means for abutting the includes a “pivotal stop plate, with an abutment surface configured to abut a bone, wherein the abutment surface is located on both sides of the ruler in a plane that is generally transverse to the longitudinal direction of the ruler.”

One example of an embodiment of the invention of Claims 10 and 30 is shown in Applicants’ Figures 2-4, which includes stop plate 30. As can be seen in these figures, stop plate 30 is pivotal about a pivot point located at the center of aperture 72 (Figure 2), where such pivotal action about a pivot point is defined in Claim 10. Further, Figures 2, 3, and 4 also show the pivotal stop plate 30 of Claim 30, that includes abutment surface 126 (Figures 3 and 4) that is located on both sides of the ruler 22 in a plane that is generally transverse to the longitudinal direction 36 of the ruler.

In contrast, Applicants respectfully submit that element 23 of the Knebelman device cannot be considered as the claimed “stop plate” of Claims 10 and 30. With regard to Claim 10, Applicants respectfully submit that element 23 is not “pivotal, with respect to a

pivot point on the ruler.” When screw 27 of the Knebelman device is loosened, sleeve 17 (as well as attached element 23) is free to slide along scale 25 and to rotate about scale 25. However, such rotation cannot be considered as the claimed “pivotable” action, because it does not pivot about a pivot point, but instead rotates about an axis. Similarly, element 23 of the Knebelman device can not be considered as being “pivotable” as defined in independent Claim 30 either. Further, element 23 of the Knebelman reference cannot be considered as the claimed “means for abutting” of Claim 30 because it also lacks the claimed “abutment surface” that is “located on both sides of the ruler.” In contrast, as shown in Figures 2 and 3 of the Knebelman reference, element 23 is only located on the bottom of ruler 13, and not in any two areas that can be considered as “both sides” of the ruler. Accordingly, for all of these reasons, Applicants respectfully request the withdrawal of this §102(b) rejection of independent Claims 10 and 30 and associated dependent Claims 16, 17, 32 and 38.

Claims 1, 3-6, 10, 16-18, 30, 32 and 36-38 stand rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 3,672,990 to Gilmer. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the Gilmer reference fails to disclose all of the features of the present invention. More specifically, the Gilmer reference fails to disclose, *inter alia*, the abutment surface of independent Claim 1 that is “configured to abut a bone, and . . . is positioned on both sides of the ruler.” Additionally, the Gilmer reference fails to disclose, *inter alia*, the abutment surface of independent Claim 10 that is “generally symmetric with respect to both sides of the longitudinal axis defined by the ruler.” Finally,

the Gilmer reference fails to disclose, *inter alia*, the abutment surface of independent Claim 30 that is “located on both sides of the ruler in a plane that is generally transverse to the longitudinal direction of the ruler.”

In contrast, the device of Gilmer lacks the features described above. More specifically, the device of Gilmer lacks the claimed abutment surface defined in independent Claims 1, 10 and 30. Upon viewing Figures 1 and 2 of the Gilmer reference, it appears as though the surface of arm D directed towards the top of the page is the feature that most closely resembles the abutment surface. However, this surface cannot be considered as the claimed abutment surface of Claim 1 because it not configured to abut a bone, nor is it positioned on both sides of the ruler designated as “C,” as defined in independent Claim 1. Further, the upward facing surface of arm D of Figures 1 and 2 of Gilmer is not generally symmetric with respect to both sides of a longitudinal axis defined by the ruler C, as defined in independent Claim 10. Finally, the upward facing surface of arm D of Gilmer is not located on both sides of the ruler C in a plane that is generally transverse to the longitudinal direction of the ruler C, as defined in independent Claim 30. Accordingly, as all of the features of independent Claims 1, 10 and 30 are not disclosed in the Gilmer reference, Applicants respectfully request the withdrawal of this §102(b) rejection of independent Claims 1, 10 and 30 and associated dependent Claims 3-6, 16-18, 32 and 36-38.

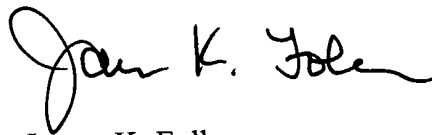
For all of the above reasons, Applicants request reconsideration and allowance of the claimed invention. Should the Examiner be of the opinion that a telephone conference

would aid in the prosecution of the application, or that outstanding issues exist, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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